

REMARKS

This Response is submitted in reply to the Final Office Action dated April 18, 2008 in conjunction with the enclosed Request for Continued Examination. Applicant has amended claims 1, 5, 11, 15, 21, 22, and 26. No new matter has been added by these amendments. Please charge Deposit Account No. 02-1818 for all payments due in connection with this Response.

As noted above, Applicant has filed a Request for Continued Examination with this Response. Accordingly, Applicant requests that the Examiner provide an upcoming Office Action which will “. . . identify any claims which he or she judges, as presently recited, to be allowable and/or . . . suggest any way in which he or she considers that rejected claims may be amended to make them allowable” in accordance with §707.07(d) of the MPEP.

The Office Action rejected Claims 1 to 4, 9, 10, 21 to 25, and 29 to 31 under 35 U.S.C § 102(b) as being anticipated by U.S. Patent No. 5,393,057 to Marnell (“*Marnell*”). Applicant respectfully disagrees with and traverses these rejections. Nonetheless, to advance prosecution, Applicant has amended certain of the claims for clarity.

Marnell discloses an electronic gaming apparatus which includes:

a display and input buttons for play of a primary game, such as a poker game; and electronic secondary gaming device, such as a bingo-type gaming device, including a display, such as a bingo matrix having a plurality of spaces. The poker gaming device and the bingo-type gaming device are electrically connected together. In one embodiment of the invention, the bingo matrix spaces are filled by a random generator device with indicia related to the primary gaming device. When predetermined results occur in the primary game, such as a poker hand or slot machine set of reels, these results are automatically entered in the secondary game.

Marnell discloses that the secondary game includes “game simulations which are based upon, connected with, or derived from, a conventional bingo game.” *Marnell*, column 5, lines 29 and 30. If a poker hand of the primary game of *Marnell* meets the poker game criteria for a winning hand, the occurrence of the winning hand “either enables or automatically produces an entry into bingo matrix 51, if the bingo matrix also

includes the winning hand.” *Marnell*, column 5, lines 65 to 68. If the bingo matrix includes duplicate indicia representing the winning poker hand, *Marnell* discloses that a random computer selection or user selection could be made as between duplicates. See *Marnell*, column 5, lines 51 to 60. In *Marnell*, the player “may continue to play poker gaming apparatus 22 until a BINGO is achieved in bingo gaming apparatus 23, at which point game apparatus 21 will award money, awards or benefits for winning the bingo game.” *Marnell*, column 6, lines 18 to 22.

The method of operating a gaming system of amended independent Claim 1 includes, among other elements: presenting a play of a main game including: randomly generating and displaying at least a first set of cards to generate a main game hand, determining an outcome of the play of the main game comprising comparing the main game hand to a set of predetermined winning hands, if the main game hand is one of the predetermined winning hands, awarding the player a winning amount and determining if the winning hand corresponds to any corresponding one of a plurality of predetermined bonus categories and, if so, associating a value with the corresponding bonus category, and allowing an input from the player at a time after determining the outcome of the play of the main game, the allowance of the input being independent of whether the main game hand is a predetermined winning hand, wherein if the input is received, the input causes play of a bonus event, the play of the bonus event comprising a random selection of at least one of the bonus categories, and awarding a bonus win according to the value, if any, associated with the at least one selected bonus category.

The Office Action interpreted the individual symbol positions of the bingo matrix of *Marnell* to correspond to the bonus categories, and the entry produced into the bingo matrix of *Marnell* to correspond to the random selection of one of the bonus categories. Page 6 of the Office Action stated that “*Marnell* teaches a player input portion of the primary game causing play of the bonus game after the placement of a wager as a Discard/Keep feature...” and that “this feature qualifies as a player input and in addition thereto causes the participation in the bonus game through effecting [*sic*] the game outcome.” Even under the Office Action’s interpretation of *Marnell*, *Marnell* does not

disclose allowing an input from the player at a time after determining the outcome of the play of the main game, the allowance of the input being independent of whether the main game hand is a predetermined winning hand, wherein if the input is received, the input causes play of a bonus event.

Under the Office Action's interpretation, *Marnell* discloses a player input which affects the outcome of the primary game and thereby causes participation in the secondary game. However, unlike the method of operating a gaming device of amended independent Claim 1, *Marnell* does not disclose allowing a player input at a time after determining the outcome of the play of the main game, the allowance being independent of whether the main game hand is a predetermined winning hand, wherein the input causes play of a bonus event. Although *Marnell* discloses user selection as between duplicate bingo positions after an occurrence of a winning hand in the primary game, *Marnell* enables this user selection feature only when the poker hand of the primary game is a winning hand. Thus, unlike the method of operating a gaming device of amended independent Claim 1, *Marnell* does not disclose that the allowance of the input is independent of whether the main game hand is a predetermined winning hand. In contrast, amended independent Claim 1 is directed to a method of operating a gaming device which includes, among other elements: allowing an input from the player at a time after determining the outcome of the play of the main game, the allowance of the input being independent of whether the main game hand is a predetermined winning hand, wherein if the input is received, the input causes play of a bonus event.

For at least these reasons, amended independent Claim 1 is patently distinguished over *Marnell* and is in condition for allowance. Claims 2 to 4, 9, and 10 depend directly or indirectly from amended independent Claim 1 and are allowable for similar reasons, and because of the additional features recited in these claims.

Amended independent Claim 21 recites similar elements as amended Claim 1 and is allowable for similar reasons. Amended Claim 22 and Claims 23 to 25, and 29 to 31 depend directly or indirectly from amended independent Claim 21 and are allowable for similar reasons, and because of the additional features recited in these claims.

The Office Action rejected Claims 5 to 8, 15 to 18, and 26 to 28 under 35 U.S.C. § 103(a) as being unpatentable over *Marnell*, and further in view of U.S. Patent No. 6,419,579 to Bennett ("*Bennett*"). Although the Office Action did not reject Claim 29 under these references, Applicant is treating Claim 29 as though it is rejected under these references because Claim 29 depends directly from Claim 26 which is rejected under these references, and because Claim 29 includes similar elements as Claims 8 and 18, which are also rejected under these references. Applicant disagrees with, and traverses these rejections.

As described above, *Marnell* discloses an electronic gaming apparatus which includes a primary game and a secondary game, such as a bingo-type game. If a poker hand of the primary game meets the poker game criteria for a winning hand, the occurrence of the winning hand either enables or automatically produces an entry into the bingo matrix, if the bingo matrix also includes the winning hand. *Bennett* discloses a bonus event wherein a symbol, such as one or more dice, is displayed to indicate a multiplier, which is used in combination with a value generated in a main game to determine an additional payout amount.

Page 4 of the Office Action states that *Marnell* is "silent regarding the utilization of two dice to determine a multiplier utilized in combination with a bonus winning to determine an additional payout amount..." The Office Action further states that "it would have been obvious to one of ordinary skill in the art at the time of invention to have incorporated the utilization of dice to determine a supplemental prize multiplier as taught by *Bennett* into the invention of *Marnell* in order to maintain a player's interest in a gaming machine as taught by *Bennett*." Applicant respectfully disagrees and submits that regardless of whether it would have been obvious to incorporate the utilization of dice to determine a supplemental prize multiplier into *Marnell*, unlike the methods of operating a gaming device of amended Claims 5, 15, and 26, and Claims 6 to 8, 16 to 18, and 27 to 29, neither *Marnell* or *Bennett*, individually, nor the methods of operating a gaming device resulting from the combination of *Marnell* and *Bennett* disclose allowing an input from the player at a time after determining the outcome of the play of the main game, the allowance of the input being independent of whether the main game hand is

a predetermined winning hand, wherein if the input is received, the input causes play of a bonus event. Moreover, it would not have been obvious to one of ordinary skill in the art to modify *Marnell* in view of *Bennett* to result in such methods of operating a gaming device without reasonably being construed as improper hindsight reconstruction.

For at least these reasons and because of the additional features recited in these claims, amended Claims 5, 15, and 26, and Claims 6 to 8, 16 to 18, and 27 to 29 are patently distinguished over *Marnell* in combination with *Bennett*, and are in condition for allowance.

The Office Action rejected Claims 11 to 14, 19, and 20 under 35 U.S.C. § 103(a) as being unpatentable over *Marnell*. Applicant disagrees with, and traverses these rejections.

Amended independent Claim 11 includes, among other elements: if the main game hand is one of the predetermined winning hands: awarding the player a winning amount, and determining if the winning hand corresponds to any corresponding one of a plurality of predetermined bonus categories and, if so, associating one of a plurality of values with the corresponding bonus category, wherein the bonus categories include at least one bonus category associated with a value which represents a combination of all of the values associated with the remaining bonus categories, and play of a bonus event including: randomly selecting at least one of the bonus categories, and awarding a bonus win according to the value, if any, associated with the at least one selected bonus category.

The Office Action stated that *Marnell* is silent regarding the use of “a wild category symbol that represents the collective appearance of this symbol rather than [sic] accounting for relevant symbol combinations.” The Office Action also states that “the characterization of additional categories as wild categories representing the combinations for the remaining categories would have been obvious to one of ordinary skill in the art at the time of invention.” Applicant respectfully disagrees and submits that unlike the method of operating a gaming device of amended independent Claim 11, regardless of whether it would have been obvious to incorporate a wild category symbol

into *Marnell*, the modified *Marnell* method does not disclose determining if the winning hand corresponds to any corresponding one of a plurality of predetermined bonus categories, wherein the bonus categories include at least one bonus category associated with a value which represents a combination of all of the values associated with the remaining bonus categories.

As best understood by Applicant, the Office Action interprets the individual positions of the bingo matrix of *Marnell* to be bonus categories, and the Office Action is concluding that it would have been obvious to include a wild category symbol in a position in the bingo matrix of *Marnell*, such that if a wild card occurs in a poker hand of the primary game of *Marnell*, the *Marnell* gaming device produces an entry into the position of the wild category symbol in the bingo matrix. Under this interpretation, after the *Marnell* gaming device produces the entry into the position of the wild category symbol, the wild category symbol/position potentially represents a poker hand of the primary game or a value associated with the poker hand of the primary game. However, the wild category symbol/position does not represent any values of the other symbols/positions of the bingo matrix (i.e., bonus categories). Accordingly, the wild category symbol is not associated with a value which represents a combination of all of the values associated with the remaining bonus categories. Thus, unlike the method of operating a gaming device of amended independent Claim 1, *Marnell* does not disclose, anticipate, or render obvious determining if the winning hand corresponds to any corresponding one of a plurality of predetermined bonus categories, wherein the bonus categories include at least one bonus category associated with a value which represents a combination of all of the values associated with the remaining bonus categories. Moreover, it would not have been obvious to one of ordinary skill in the art to modify *Marnell* to result in such a method of operating a gaming device without reasonably being construed as improper hindsight reconstruction.

For at least these reasons and because of the additional features recited in this claim, amended independent Claim 11 is patently distinguished over *Marnell* and is in condition for allowance. Claims 12 to 14, 19, and 20 depend directly or indirectly from

amended independent Claim 11 and are allowable for similar reasons, and because of the additional features recited in these claims.

An earnest endeavor has been made to place this application in condition for formal allowance, which is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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